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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/752,396

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Luis Eduardo Gutierrez-Sheris

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EXAMINER

WINTER, JOHN M

ART UNIT

PAPER NUMBER

3685

MAIL DATE

DELIVERY MODE

04/01/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/752,396	Applicant(s) GUTIERREZ-SHERIS, LUIS EDUARDO	
	Examiner JOHN M. WINTER	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-85 and 88 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38-85 and 88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1/8/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. The Applicants amendment filed on January 6, 2009 is hereby acknowledged. Claims 38-85 and 88 are pending .

Response to Arguments

2. The Examiner states that a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed. In this particular case, claim 38 fails prong (1) because the “tie” (e.g. fund access device) is representative of extra-solution activity

3. The Applicant states that the cited references also do not, either individually or in combination, disclose or suggest accessing transferred funds in an account utilizing an activated carryable funds-access device.

The Examiner responds that Walker et al. discloses a device implemented as a “smart card” -- “FIG. 1 is a schematic diagram of a device 100 for generating a single-use credit card number in accordance with this invention. This device is preferably a smart card, hereinafter referred to as the “device.” The device has a keypad 103, a display screen 102, a memory 104 and a central processor 101.” (Column 5, lines 49-61). The Examiner submits that even if implemented as a full sized keyboard and monitor “smart card” as disclosed by Walker still meets the claimed limitation of a “carryable device”. Walker further discloses that the device is “activated” -- “The device may be activated through the input of a unique cardholder identifier such as a personal identification number (PIN) through the keypad 103. Alternatively, the device may include a biometric interface 105, and be activated by the input of a suitable biometric record such as the cardholder's fingerprint.” (Column 5, lines 49-61)

4. In regard to claims 39, 50, 61 and 74, Walker states “ This invention provides a method and a device to facilitate secure electronic commerce, secure remote credit card purchases, and secure conventional credit card purchases wherein the customer is assured that the merchant or an intercepting third party cannot misuse any credit card information.” Column 3, lines 59-64, the Examiner submits that that financial instrument (i.e. the device) is an instrument representative of a funds-transfer.

5. The Examiner states that although Walker does not mention the specific embodiment of an “ATM” machine it is obvious that the functions described by Walker could be implemented as an ATM card without any alteration of the disclosed invention.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 38-85 and 88 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
7. . Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

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To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed. In this particular case, claim 38 fails prong (1) because the “tie” (e.g. fund access device) is representative of extra-solution activity. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

8. Claims 39-85 are also rejected as each depends from claim 38 or contains similar limitations.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 38-85 and 88 are rejected under 35 U.S.C. 103(a) as being obvious in view of Walker et al. (U.S. Patent 6,163,771) in view of Gifford (US Patent 6,049,785)
10. As per claim 38

Walker et al. discloses a method for accessing funds associated with a financial instrument, comprising:

- generating a funds-access code (Abstract – account identifier);
- associating the generated funds-access code with a financial instrument (Column 7, lines 4-9);
- supplying the generated funds-access code to a recipient (Column 6, lines 15-29);
- presenting the funds-access code by the recipient to a distributor (Column 6, lines 15-29);
- creating and storing a funds-access device record representing the activated funds-access device;
- associating the funds-access device record with funds associated with the financial instrument; and
- accessing the funds associated with the financial instrument upon utilization of the activated funds-access device by the recipient (Figures 11A and B).

Applicant(s) are reminded **that optional or conditional elements do not narrow the claims (i.e. upon activation)** because they can always be omitted. See e.g. MPEP §2106 II C: “Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.] ” As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.

Walker et al. does not explicitly disclose “activating a carryable funds-access device in response to the recipient presenting the funds-access code to the distributor”, Gifford discloses “activating a funds-access device in response to the recipient presenting the funds-access code to the distributor”. (Column 5, lines 49-61; Column 11, lines 29-41; figure 7

it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Walker et al. method with the Gifford method in order in order to allow spontaneous purchasing.

11. As per claim 39

Walker et al. discloses the method of claim 38, wherein the financial instrument is an instrument representative of a funds-transfer (column 3, lines 59-64 -- i.e. making a purchase) .

12. As per claim 40

Walker et al. discloses the method of claim 38, wherein the financial instrument is a check, and the funds-access code is a check number (Figures 11a and b – the process is analogous to using a check number).

13. As per claim 41

Walker et al. discloses the method of claim 38, wherein the funds-access device is a carrying card having a magnetic stripe containing data; and the step of accessing the funds is carried out upon reading the data from the magnetic stripe on the carrying card.(Column 5, line 51)

14. As per claim 42

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Walker et al. discloses the method of claim 38,
wherein the step of activating a funds-access device further includes the step of providing the recipient with a personal code, and wherein the step of accessing the funds is carried out by utilizing the funds-access device and providing the personal code by the recipient.
(Column 6, lines 39-53)

15. As per claim 43

Walker et al. discloses the method of claim 42,
wherein the funds, access device is an ATM card usable at automatic teller machines and the personal code is a PIN; and wherein the step of accessing the funds is carried out by the recipient supplying the ATM card and the PIN to one of the automatic teller machines.
(Column 6, lines 39-53)

16. As per claim 44

Walker et al. discloses the method of claim 43,
wherein the step of accessing the funds is carried out by the steps of requesting by the recipient a designated amount of cash, dispensing by the automatic teller machine the requested cash, and updating the financial instrument associated with the funds to reflect dispensing of the designated amount of cash to the recipient. (Column 6, lines 39-53)

17. As per claim 45

Walker et al. discloses the method of claim 38,

further comprising the steps of storing the financial instrument and the funds-access device in a relational database (Figure 12).

18. As per claim 46

Walker et al. discloses the method of claim 38, further comprising the steps of specifying a selected recipient by the financial instrument and associating the financial instrument with a receiving financial instrument identity record identifying the recipient. (Column 6, lines 39-53)

19. As per claim 47

Walker et al. discloses the method of claim 46, further comprising the step of verifying by the distributor a matching of the identity of the recipient to an identity identified by the receiving financial instrument identity record of the financial instrument associated with the supplied funds access code, and wherein the steps of activating and accessing steps are carried out only if the match is verified (Figures 11 A and 11B).

20. As per claim 48

Walker et al. discloses the method of claim 47, wherein the financial instrument, the funds-access device record, and the receiving financial instrument identity record are stored in a relational database (Figure 12).

21. Claims 49- 85 and 88 are not patentably distinct from claims 38-48 and are rejected for at least the same reasons.

Conclusion

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMW

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685